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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/338,209	06/22/1999	MARSHALL MEDOFF	08895/006001	1113

26161 7590 12/26/2002

FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

BEFUMO, JENNA LEIGH

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 12/26/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

A274

Office Action Summary

Application No.

09/338,209

Applicant(s)

MEDOFF ET AL.

Examiner

Jenna-Leigh Befumo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 1-6,8,9 and 12-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7,10,11 and 37-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Amendment A, submitted as Paper No. 13 on October 28, 2002, has been entered. Claim 7 has been amended and claims 37 – 44 have been added. Therefore, the pending claims are 1 – 44. Claims 1 – 6, 8, 9, and 12 – 36 are withdrawn from consideration as being drawn to a nonelected invention.

2. Amendment A is sufficient to overcome the 35 USC 112 2nd rejection to claim 7 set forth in section 2 of the previous Office Action.

3. Additionally, Amendment A is sufficient to overcome the 35 USC 102 and 35 USC 103 rejections based on Erickson (4,020,212) since Erickson fails to teach that the fibrous material is made from cellulosic material.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 7 and 37 – 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Mamers et al. (4,188,259).

Mamers et al. is drawn to a method for recovering fiber from laminated carton boards (abstract). The carton boards can include laminated paper products used for packaging juices and milk (column 1, lines 9 – 11). Mamers et al. liberated the pulp material by placing shredded pices of the laminate in a pulping liquor, which is heated to a temperature above the melting temperature of the thermoplastic material in the laminate, followed by cooling the liquor to a temperature below the softening point of the thermoplastic material, subjecting the mixture to defibration forces to produce thermoplastic fragments and cellulosic fibers, and finally, separating the materials (column 2, lines 28 – 48). The pulped may then be cleaned of the remaining thermoplastic material by know means, producing clean separated cellulosic fibers (column 7, lines 33 – 35). Therefore, the fibers are completely separated from the thermoplastic material and 100% exposed. Further the defibration process would also texturized the fibers to some degree. Thus, claims 7 and 37 – 44 are anticipated.

7. Claims 7 and 37 – 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishibori (5,871,161).

Nishibori et al. discloses a process for individually collecting layers from a laminated film by shredding the laminated material into a plurality of fragments and then peeling and separating the materials in the fragments (abstract). Materials which can be separated include various types of laminated paper products including milk cartons (column 4, line 61 – column 5,

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line 25). The peeling and separating step separates the individual layers producing disentangled minute fibers, thin strips of plastic fragments and thin strips of foil fragments (column 8, lines 59 – 65). The fibrous paper layer has 100% of the internal fibers exposed via the peeling and separating step. This process would also inherently texturized the fibers to some degree. After separating the fibers, the fibrous material is passed through a screen and collected in a collecting tank (column 9, lines 10 – 29). Thus, claims 7 and 37 – 44 are anticipated.

8. Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Lamb, Sr. (5,137,668).

The features of Lamb, Sr. have been set forth in the previous Office Action. Lamb, Sr. teaches shredding poly-coated paper into small pieces approximately 3/8 inch square. Thus, the shredded paper would inherently expose at least 5% of the internal fibers, since the shredded pieces expose the internal fibers at the torn edges.

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamb, Sr. for the reasons of record.

11. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mamers et al. and Nishibori.

The features of Nishibori and Mamers et al. have been set forth above. While Nishibori and Mamers et al. discloses the fibers are separated to form pulp and collected to be used later, Mamers et al. and Nishibori fail to teach the bulk density of the separated fibers. However, it would have been obvious to one having ordinary skill in the art at the time the invention was

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made to choose the claimed, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215. In this case, it would have been obvious to one of ordinary skill in the art to vary the bulk density of the pulp material for various end uses depending on the desired end properties, such as insulation, cushioning, weight, and hand. Therefore, claims 10 and 11 are rejected.

Further, the pulp fibers in Nishibori are collected by dropping through a screen. Therefore, the collected pulp would have a low bulk density since Nishibori et al. doesn't teach compressing the pulp as it is being collected.

Response to Arguments

12. Applicant's arguments filed October 28, 2002 have been fully considered but they are not persuasive. The Applicant argues that Lamb, Sr. exposes less than 5% of the internal fibers. However, the Applicant has not provided any persuasive evidence that establishes this point. Lamb, Sr. discloses the material is torn up into small pieces. Thus, every torn edge exposes the internal fibers at that point. Therefore, it is felt by the Examiner that this would expose at least 5% of the internal fibers since numerous fibers are exposed at each torn edge. Thus, the rejection is maintained.

13. Finally, while it is noted that the process described by the Applicant and Mamers et al. the final end product would read on the claims as recited, since both references produce pulp from poly-coated paper products. Additionally, it is felt that the process taught by Nishibori et al. is similar to the Applicant's since Nishibori discloses stripping the shredded pieces so that the polymer layer is separated from the paper layer thus exposing and disentangling the fibers.

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Therefore, the material taught by Nishibori et al. is thought to be similar in structure and composition to the pulp material in this invention.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (703) 605-1170. The examiner can normally be reached on Monday - Friday (9:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Jenna-Leigh Befumo
December 19, 2002


TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700